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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,541	09/08/2003	Jeffrey T. LaBelle	9138-0092US	3256
28529	7590	07/02/2004	EXAMINER	
GALLAGHER & KENNEDY, P. A. 2575 E. CAMELBACK RD. #1100 PHOENIX, AZ 85016			KOSSON, ROSANNE	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/658,541	LABELLE ET AL.	
	Examiner	Art Unit	
	Rosanne Kosson	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34, drawn to a hybrid photoactive device and a method of making a hybrid photoactive device, classified in class 435, subclass 176.
- II. Claims 35-39, drawn to a method of making a hybrid device comprising a biological component, classified in class 435, subclass 6.
- III. Claim 40, drawn to a method of analysis of a component or device that is at least partly biological, classified in class 435, subclass 4.
- IV. Claims 41-43, drawn to a method of making biological components for hybrid devices, classified in class 435, subclass 29.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-IV are unrelated processes. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group I is directed to a hybrid photoactive device and a method of making a hybrid photoactive device. The invention of Group II is directed to a method of making a hybrid device with a biological component comprising identifying performance characteristics of the biological component and calculating a co-efficient of merit. The invention of Group III is directed to a method of analysis of a partly biological device whose biological components are grown under controlled conditions, and the invention of Group IV is direct to a method of

making biological components comprising deriving a figure of merit for partly biological devices. Clearly, these various processes have different modes of operation, functions and effects, as the process of any one of the inventions may be carried out without requiring the process of a different invention.

The hybrid photoactive device recited in the product claims of Group I (claims 1-14) may made or used by processes other than the inventions of Groups II-IV. The device may be made by the process of Group I, rather than the process of Group II or Group IV, with respect to making the biological components. The device may be used other than by the process of Group III. For example, the device may be used as a biosensor, rather than as a sample that is analyzed, in which transfer functions are formulated from outputs of the biological components. Thus, claims 1-14 of Group I and the inventions of Groups II-IV are distinct, as the product as claimed can be made by another and materially different process (MPEP § 806.05(f)) and used by another and materially different process (MPEP § 806.05(h)).

Because these inventions are distinct for the reasons give above and have acquired a separate status in the art as shown by their separate classifications, restriction for examination purposes as indicated is proper. Furthermore, the search required for one group is not required for another group, and searching the different groups would create an undue burden of search. Because these inventions are separate and distinct for the reasons given above, restriction for examination purposes as indicated is proper.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants are advised that, for the reply to this requirement to be complete, an election of the invention to be examined must be included even though the requirement be traversed (37 CFR §1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rosanne Kosson
Examiner
Art Unit 1651

Irene Marx
IRENE MARX
PRIMARY EXAMINER

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2004-06-28